

REMARKS

I. Status of the Claims

As a part of the preliminary amendment filed along with this application, claims 17-29 were filed in place of original claims 1-16. Upon entry of the present amendment, claim 29 is amended to recite "a plurality of sample fragments" instead of "said plurality of polynucleotide sample fragments" to ensure proper antecedent basis. Claim 29 is also amended to replace the term "a (the) third primer sequence" with the term "an (the) additional polynucleotide sequence." This amendment finds support in the specification, *e.g.*, on pages 19-20 as well as in Figures 1A and 1B, where it is indicated that the linker may be a polynucleotide (page 20, lines 1-2). In other words, the linker may provide an additional polynucleotide sequence. No new matter is introduced by this amendment.

II. Amendment to the Specification

The specification is amended, per the Examiner's request, to update priority information. No new matter is introduced.

III. Claim Rejections

A. 35 U.S.C. §112, Second Paragraph

Claim 29 was rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. Specifically, the Examiner asserted that the term "said plurality of sample fragments" lacks antecedent basis. As amended, this term is now replaced by "a plurality of sample fragments." Applicants thus submit that indefiniteness rejection is overcome.

B. 35 U.S.C. §112, First Paragraph

Claim 29 was rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to meet the written description requirement. Specifically, the Examiner asserted that the term "third primer sequence" is without support in the originally filed specification and therefore constitutes new matter. Applicants do not agree. To expedite prosecution, however, Applicants have amended claim 29 to recite, instead of "a (the) third primer," the term "an (the) additional polynucleotide sequence." As pointed out above, and apparently recognized by the Examiner,

this term is fully and literally supported by the specification on page 20, lines 1-2, where it is stated that a linker may be a polynucleotide sequence. Thus, the withdrawal of the written description rejection is respectfully requested.

C. Double Patenting

Claims 17-28 were rejected under the judicially created doctrine of obviousness-type of double patenting as being allegedly unpatentable over claims 1-13 of U.S. Patent No. 5,935,793 ("the '793 patent"). In response, a terminal disclaimer disclaiming the patent term beyond that of the '793 patent is filed herewith.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Chuan Gao
Reg. No. 54,111

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
CG:cg
60651285 v1